

REMARKS

The Examiner rejected Claims 1-4, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Antczak et al. U.S. 5,934,530 in view of Brenning Jr. (U.S. 4,131,952). . The Examiner rejected Claims 1,3,5,6 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Johnson Rabbett (US 5,392,974) in view of Brenning '952... The Examiner has rejected Claims 7 and 8 as being unpatentable over Brenning in view of Milner(U.S. 5,261,461) The Examiner rejected claims 1-17 under 35 U.S.C. §112 as being indefinite for failing to point out and distinctly claim the subject matter which the applicant regard as the invention.

Obviousness Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-4, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Antczak et al. U.S. 5,934,530 in view of Brenning Jr. (U.S. 4,131,952). .

A rejection under 35 U.S.C. § 103(a) must be supported by a prima facie case of obviousness, MPEP § 2142. "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142, pg. 2100-121.

The first element in establishing a prima facie case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143. The second element is that there must be a reasonable expectation of success. *Id.* The third element is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.* "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper); *see* MPEP § 2143.01.

The relevant facts for finding obviousness relate to (1) the scope and content of the prior art, (2) the level of ordinary skill in the field of the invention, (3) the differences between the claimed invention and the prior art, and (4) any objective evidence of nonobviousness such as long felt need, commercial success, the failure of others, or copying. *Graham v. John Deere Co.*, 148 U.S.P.Q. 459, 467 (U.S. 1966). The obviousness analysis articulated by the United States Supreme Court in *Graham* requires that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved

Claim Rejections 35 USC 103.

Response to Detailed Action

Response to Item 8:

The examiner states that Antczak teaches a protective shield comprising a plurality of sleeves whose first ends are open and whose second distal ends are closed, a palmar shield of finite extent having first and second surfaces and first and second edges and retaining means in the form of hook and loop 19 with one complimentary fastener mounted on the host and the other on the glove at the second edge of the palmar shield.... Although these items are contained in '530, they are not configured to operate as claimed in the present invention. For example, the protective shield 53 does not have only a palmar shield. It contains both palmar and back hand shields which act against the ease of inserting the fingers in the sleeves. Furthermore, Antczak does not teach any finger rings that would hold the first terminal end of the finger sleeves open as taught by LeVert et al., which would enhance the ability of a user to insert a hand into the protective shield. Even with insertion of the rings of Brenning, it is clear that the glove of Antczak with its palmar and back hand shields that a user is required to use a two handed effort for easy insertion of a hand. The protective shield of LeVert et al. is designed to prevent the need for any hand of a user from coming in contact with the first surface of the apron 14 or the outer surface of the finger sleeves 8, 6 and 4, which can occur if one has to use a second hand to grasp the protective shield. Further Antczak teaches a device for organizing and holding golf accessories such as a golf glove comprising: a palmar shield, a back of the hand shield and a multiplicity of sleeves. He does not evidence any desire to develop a device for protecting the fingers and hand from disease and viruses. Nor does he evidence any desire to provide a glove into which a hand can be easily inserted. Therefore even with the glove of Brenning before Antczak it would not be obvious to one of skill in the art of making golf holding accessories to add the rings of Brenning to the glove accessory

The Examiner also states that: "Brenning teaches a glove 11 with rings 24, 25 mounted in first ends of sleeves 12a-12e. The rings inherently maintain the first end of the sleeves in an open circular configuration, thus facilitating finger insertion. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Antczak's glove with rings as taught by Brenning, maintain the shape of the finger sleeves." First, as stated above there is no motivation on the part of Antczak to utilize finger rings in his glove. Secondly, there must be a reasonable expectation of success if combinations are used to establish obviousness. The apparatus of the first embodiment is designed to facilitate the insertion fingers of a single hand into the protective shield. In the discussion of the use and function of the apparatus, the inventors states: "In this case, the user, utilizing the apparatus of the first embodiment, insert the thumb, index and middle fingers into the

sleeves and breaks the bonding of loop 26b and hook26a”. If the rings of Brenning are added to the glove of Antczak, one can not create the apparatus of LeVert et al.

Response to Item 9:

The Examiner states that: “claims 1, 3, 5, 6, and 15-17 are rejected under 35 USC 103(a) as being unpatentable over Johnson –Rabbett(JR, U.S. 5,392,974) in view of Brenning ‘952. JR discloses the invention substantially as claimed. JR teaches a protective shield shown in Figure 1 and described in the specification as sterile surgical glove, comprising a plurality of sleeves whose first ends are open and whose distal ends are closed, a palmar shield of finite extent having first and second surfaces and first and second edges, and retaining means in the form of a portable container (shown but not labeled)”. The applicants were unable to identify the protective shield of JR ‘974 in Figure 1 mentioned by the examiner. JR ‘974 discloses a glove holder pouch from which sterile gloves are dispensed one at a time by pulling the gloves through a slit after which the gloves are placed on both hands. LeVert et al teaches a protective shield with hook and loop means that attaches the protective shield to a host via a belt or other means that remains in place until a multiplicity of fingers are inserted into sleeves and the insert hand used to break the bond between the hook and loop means.. To utilize one of the gloves from the pouch of JR as protective would normally require the use of two hands when inserting a hand into the open end of the glove which contains a palmar and back of the shields. Further, the existence of the back of the hand shield prevents the combination of the shield of JR and rings of Brenning from satisfying the third element for obviousness discussed above. In studying references cited by the examiner, the applicants could not find any suggestion or motivation, either in the JR ‘974 or Brenning ‘952 references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. The applicants believe, after reviewing the prior art presented by the Examiner, that there is no motivation for one of ordinary skill in the art of surgical gloves to combine the rings of Brenning with gloves of JR ‘974 to create the protective shield of LeVert et al. Moreover, such a combination would not be successful as sterile surgical gloves or as protective shields because the rings of Brenning are designed to separate from the body of the glove when subjected to a small tensional force, which would expose the fingers to undesirable elements. The response to Item 8 can also be applied in this instance to demonstrate that a prima facie case of obviousness was not established by recourse to JR and Brenning.

Response to Item 10

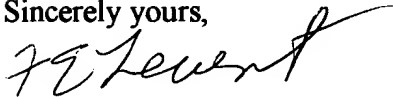
In Item 10 the Examiner states that: “Claim 7 and 8 are rejected under 35 USC (a) as being unpatentable over JR/Brenning as applied to claim 6 above, and further in view of Milner (U.S. 5,261,421). JR/Brenning discloses the invention substantially as claimed and discussed above. However, JR/Brenning does not teach means comprising disinfectants, fungicides in cooperation with a binding agent...protective shield.” The Examiner also states that: “Milner ‘421 recites in column 2, lines 40-50 that it is known in the art to provide gloves with antimicrobial agents in a binding agent for coating glove’s surface. Therefore, it would be obvious to provide JR’s glove with a disinfectants or fungicides in cooperation with

a binding agent as taught by Milner, because this common method of maintaining the disinfecting integrity of the glove.” As discussed in Items 8-9, there must be: a) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; b) a reasonable expectation of success; and, c) prior art reference (or references when combined) that suggest all the claim limitations. In the discussions above, the applicants have demonstrated that neither of these requirements is met by the combinations of references cited by the examiner. The glove of JR has a palmar and back of the hand shield while LeVert et al. has a palmar shield only. The rings of Brenning are designed to facilitate the separation of the sleeves from the glove body when subjected to a small tensile force which would defeat the purpose of the finger – palm shield because the fingers would be exposed.

Affordable Subject Matter Item 11

In Item 11 the Examiner states that: “Claims 9-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. Also see any applicable claim, specification, or drawing objections noted above.” The Claims 9-12 are corrected as suggested by the Examiner.

Sincerely yours,



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